

## Remarks

### **1. Summary of the Office Action**

In the final office action mailed August 5, 2008, the Examiner maintained the rejection of claim 20 under 35 U.S.C. § 101 as allegedly being directed to non-patentable subject matter. In addition, the Examiner maintained rejections of claims 1-6 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2003/0083041 (Kumar), and the Examiner rejected claims 13-25 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,987,987 (Vacanti).

### **2. Status of the Claims**

Pending are claims 1-6 and 13-25, of which claims 1, 4, 13, 16, and 20 are independent and the remainder are dependent.

### **3. Response to § 101 Rejection**

The Examiner rejected claim 20 as allegedly being directed to non-patentable subject matter, on grounds that the claim allegedly covers embodiments directed to software per se. Applicant submits that this §101 rejection is improper and should be withdrawn, because claim 20 clearly recites subject matter beyond mere software.

Claim 20 recites, *inter alia*, "a network interface for receiving and sending communications on the HTTP communication path, wherein the network interface receives a communication that carries web content and the web content defines a hyperlink that points to referenced web content". In the final office action, the Examiner acknowledged the fact that Applicant's arguments regarding now-cancelled claims 7 and 10 were persuasive, as those claims recited, *inter alia*, a network interface for receiving and sending communications. Claim 20 just

as well recites, *inter alia*, a network interface for receiving and sending communications. Even if software is involved in implementing functions recited, the physical network interface element clearly makes claim 20 directed to more than mere software.

Because claim 20 is directed to patentable subject matter, Applicant respectfully requests withdrawal of the § 101 rejection.

#### **4. Response to § 102 Rejections of Claims 1-6**

The Examiner rejected claims 1-6 as being allegedly anticipated by Kumar. Applicant respectfully submits that the rejections of these claims are improper and should be withdrawn, because Kumar does not disclose (expressly or inherently) each and every element of any of these claims.

In Applicant's remarks in the previous response, Applicant made arguments about certain recitations in claims 1 and 4. In the final office action, the Examiner then alleged that those limitations occurred in the claim preambles and were therefore given no patentable weight. Applicant submits that the Examiner's reading of the claims is incorrect, as the recitations at issue are not part of the claim preambles but are, rather, integrally part of the other recitations that also follow the preamble. Consequently, the Examiner erred in giving the limitations no patentable weight.

In the following subsections, Applicant will reiterate the arguments as to why claims 1-6 clearly distinguish over Kumar. In the process, Applicant will explain specifically why the argued recitations are not part of the claim preambles and therefore why the limitations should properly be given patentable weight.

a.      **Claims 1-3**

Of these claims, claim 1 is independent. Kumar fails to anticipate claim 1, at a minimum because Kumar fails to teach carrying out the computing, engaging, and sending functions *during transmission of the web request within the communication path from the client station to the content server* as claim 1 recited originally and still recites in its amended form. At best, Kumar merely teaches a wireless communication device (client station) itself estimating a cost based on quantity of data to be communicated, and presenting the estimate to a user of the wireless communication device before proceeding with session initiation. Functions carried out at the wireless communication device, according to Kumar, cannot occur during transmission of the web request within the communication path from the client station to the content server as recited in claim 1. Further, considering the amended language of claim 1, the functions carried out at the wireless communication device, according to Kumar, cannot occur *between the client station and the content server* as in claim 1.

The Examiner asserted that the recitation "during transmission of the web request within the communication path, between the client station and the content server" should be given no patentable weight, as the Examiner considered that limitation to occur within the preamble. A reading of the claim makes clear, however, that the language "during transmission of the web request within the communication path, between the client station and the content server" is actually an integral element of the body of the claim. The language follows the phrase "the method comprising" and the language specifically qualifies the subsequent list of functions. Claim 1 does not merely recite in its body the limitations of "computing...", "engaging...", and "...sending...." Rather, the claim expressly recites *the method comprising*: "during transmission

of the web request within the communication path, between the client station and the content server", "computing...", "engaging...", and "...sending...."

Applicant understands that the format of the claim may have led the Examiner to an initial reaction that everything preceding the colon in the claim is preamble, and everything following the colon is the body of the claim. However, a review of the claim shows that that is not the case. The preamble ends with the phrase "the method comprising". The body of the claim then recites three elements each qualified by the language of "during transmission of the web request within the communication path, between the client station and the content server."

The Examiner has relied on the *In re Hirao* and *Korpa v. Robie* cases as supporting a conclusion that language in a preamble is not to be given patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness, but instead, the process steps or structural limitations are able to stand alone. That principle of law, however, is inapplicable here, because the language at issue is not language of the preamble but rather follows the preamble-concluding phrase "the method comprising", notwithstanding that a colon follows the language. Any contrary conclusion would improperly exalt form over substance.

Furthermore, even if one were to interpret the language "during transmission of the web request within the communication path, between the client station and the content server" as being part of the claim preamble (which Applicant does not concede), a review of the *In re Hirao* and *Korpa* cases demonstrates that the language must still be given patentable weight, or at least that the language does not constitute the type of language that should not be given patentable weight.

The *In re Hirao* case, for instance, addressed the following claim:

1. A process for preparing foods and drinks sweetened mildly, and protected against discoloration, Strecker's reaction, and moisture absorption, which comprises:

adding  $\alpha$ -1,6-glucosidase and  $\beta$ -amylase, under such conditions and in a quantity sufficient to produce straight chain amylose, to enzymatically liquefied starch which consists essentially of amylopectin\*68 thereby producing straight-chain amylose;

subjecting the resulting amylose to the action of  $\beta$ -amylase and purifying and drying to obtain high purity maltose in crystalline powder form of 90-95% maltose; and then

adding said high purity crystalline maltose powder to foods and drinks as the essential added sweetener.

Considering this claim, the court stated that the preamble language reciting a "process for preparing foods and drinks sweetened mildly" merely recites the purpose of the process, and that the remainder of the claim (the three process steps) does not depend on the preamble for completeness and the process steps are able to stand alone.

Clearly the language at issue here ("during transmission of the web request within the communication path, between the client station and the content server") does not recite mere purpose for the process but rather specifically qualify the "computing...", "engaging...", and "...sending..." language. The "computing...", "engaging...", and "...sending..." language is thus integrally tied to the "during transmission of the web request within the communication path, between the client station and the content server" language, in great contrast to the situation in the *In re Hirao* case.

The *Korpa* case underscores the significance of language such as the "during transmission of the web request within the communication path, between the client station and the content server" language. In *Korpa*, the court noted that in cases (reviewed by the court) where the preamble to the claim was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim. In

particular, the preamble was considered necessary to give life, meaning and vitality to the claims or counts. Further, the court noted that usually, in those cases, there inhered in the article specified in the preamble a problem that transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited the elements comprising the article, and recited in the body of the claim or count following the introductory clause, so as to distinguish the claim or count over the prior art. The court then went on to conclude that the preamble language "An abrasive article" was essential to point out the invention at issue, and the court found that those introductory words give life and meaning to the invention, "for it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article." *See Korpa v. Robie*, 187 F.2d 150, 152 (CCPA 1951).

So too, in this case, the introductory language "during transmission of the web request within the communication path, between the client station and the content server" gives life and meaning to the "computing...", "engaging...", and "...sending..." language, as it is only by the "during transmission of the web request within the communication path, between the client station and the content server" language that it can be known the "computing...", "engaging...", and "...sending..." functions occur during transmission of the web request within the communication path, between the client station and the content server. Therefore, following the case law cited by the Examiner, the language "during transmission of the web request within the communication path, between the client station and the content server" in claim 1 should clearly be given patentable weight.

Because Kumar does not teach the combination of elements recited by claim 1, when the language "during transmission of the web request within the communication path, between the

client station and the content server" is properly given patentable weight, Kumar does not anticipate claim 1. Therefore, Applicant submits that claim 1 is allowable. Further, without conceding the Examiner's other assertions, Applicant submits that claims 2-3 are allowable as well for at least the reason that they depend from allowable claim 1.

**b. Claims 4-6**

Of these claims, claim 4 is independent. Kumar fails to anticipate claim 4, at a minimum because Kumar fails to teach carrying out the computing, engaging, and sending functions *during transmission of the web request within the communication path from the content server to the client station* as claim 4 recited originally and still recites in its amended form. At best, Kumar merely teaches a wireless communication device (client station) itself estimating a cost based on quantity of data to be communicated, and presenting the estimate to a user of the wireless communication device before proceeding with session initiation. Functions carried out at the wireless communication device, according to Kumar, cannot occur during transmission of the web content within the communication path from the content server to the client station as recited in claim 4. Further, considering the amended language of claim 4, the functions carried out at the wireless communication device, according to Kumar, cannot occur *between the content server and the client station* as in claim 4.

The Examiner asserted that the recitation "during transmission of the web request within the communication path, between the content server and the client station" should be given no patentable weight, as the Examiner considered that limitation to occur within the preamble. A reading of the claim makes clear, however, that the language "during transmission of the web request within the communication path, between the content server and the client station" is actually an integral element of the body of the claim. The language follows the phrase "the

method comprising" and the language specifically qualifies the subsequent list of functions. Claim 4 does not merely recite in its body the limitations of "computing...", "engaging...", and "...sending...." Rather, the claim expressly recites *the method comprising*: "during transmission of the web request within the communication path, between the content server and the client station", "computing...", "engaging...", and "...sending...."

Applicant again understands that the format of the claim may have led the Examiner to an initial reaction that everything preceding the colon in the claim is preamble, and everything following the colon is the body of the claim. However, a review of the claim shows that that is not the case. The preamble ends with the phrase "the method comprising". The body of the claim then recites three elements each qualified by the language of "during transmission of the web request within the communication path, between the content server and the client station."

The Examiner again relied on the *In re Hirao* and *Korpa v. Robie* cases as supporting a conclusion that language in a preamble is not to be given patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness, but instead, the process steps or structural limitations are able to stand alone. That principle of law, however, is again inapplicable here, because the language at issue is not language of the preamble but rather follows the preamble-concluding phrase "the method comprising", notwithstanding that a colon follows the language. Any contrary conclusion here as well would improperly exalt form over substance.

Furthermore, even if one were to interpret the language "during transmission of the web request within the communication path, between the content server and the client station" as being part of the claim preamble (which Applicant does not concede), the above analysis of the *In re Hirao* and *Korpa* cases demonstrates that the language must still be given patentable



weight, or at least that the language does not constitute the type of language that should not be given patentable weight.

Because Kumar does not teach the combination of elements recited by claim 4, when the language "during transmission of the web request within the communication path, between the content server and the client station" is properly given patentable weight, the Examiner has not made out proper case of anticipation of claim 4. Therefore, Applicant submits that claim 4 is allowable. Further, without conceding the Examiner's other assertions, Applicant submits that claims 5-6 are allowable as well for at least the reason that they depend from allowable claim 4.

#### **5. Response to § 102 Rejections of Claims 13-25**

The Examiner rejected claims 13-25 as being allegedly anticipated by Vacanti. Applicant respectfully submits that these rejections are improper and should be withdrawn, because Vacanti does not disclose (expressly or inherently) each and every element of any of these claims.

At a minimum, Vacanti does not disclose the combination of elements recited in any of claims 13, 16, and 20, including the function of computing a size-based cost to access the web content and adding an indication of the size-based cost into the web content in conjunction with the hyperlink, such that the indication of the size-based cost will be presented to a user when the web content is presented to the user.

As noted by the Examiner, Vacanti teaches embellishing a hyperlink with an indication of cost to access the referenced web content. However, Vacanti does not teach embellishing the hyperlink with a *size-based cost* to access the referenced web content. Therefore, Vacanti does not anticipate claims 13, 16, and 20.

In the final office action, the Examiner expressed disagreement with this position, by noting that Vacanti further discloses at column 20, lines 51-55, that users pay in advance for

quantity of access. However, it is clear from a reading of that section of Vacanti as a whole that the section has nothing to do with determining a size-based cost of given content. At best, that statement in Vacanti may relate to a limitation on the quantity of data being communicated. It does not teach anything about determining a cost based on a given quantity of data (if that is what the Examiner meant), and more specifically it does not disclose the claim function of computing a size-based cost to access the web content. Applicant's claims recite that function. The Vacanti reference does not teach that function.

Accordingly, Applicant submits that claims 13, 16, and 20 are allowable. Further, without conceding the Examiner's other assertions, Applicant submits that claims 14-15, 17-19, and 21-25 are allowable as well for at least the reason that they each depend from one of allowable claims 13, 16, and 20.

## **6. Conclusion**

For the foregoing reasons, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

Respectfully submitted,

**MCDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP**

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By: /Lawrence H. Aaronson/  
Lawrence H. Aaronson  
Reg. No. 35,818